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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/679,054    10/03/00    DORSCHNER

A    BEIERSDORF

EXAMINER

HM12/0316

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ART UNIT

PAPER NUMBER

1616

DATE MAILED:

03/16/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/679,054

Applicant(s)

DORSCHNER ET AL.

Examiner

Marina Lamm

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

Claims 1-4 are pending in this application filed 10/03/2000.

#### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### *Specification*

2. The abstract of the disclosure is objected to because it contains figure. Correction is required. See MPEP § 608.01(b).
3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

4. The disclosure is objected to because of the following informalities: "Brief description of the drawings" is missing.

Appropriate correction is required.

***Claim Objections***

5. Claim 1 is objected to because of the following informalities: use of bullets. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1 recites the broad recitation "an oil-in-water emulsion", and the claim also recites "in particular O/W

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microemulsion” which is the narrower statement of the range/limitation. Claim 1 also recites the broad recitation “emulsifiers not covered by the definition of emulsifier A”, and the claim also recites “ in particular those which act primarily as W/O emulsifiers” which is the narrower statement of the range/limitation. In addition, Claims 2 and 4 recite narrow concentration ranges within broad ranges which renders the claims indefinite.

Claim 1 uses improper Markush claim language: “chosen from the group of emulsifiers”. Proper Markush claim language is : “selected from the group consisting of”.

Claim 1 is also viewed as indefinite because it is unclear what emulsifiers are encompassed by the limitations set forth in lines 2-14 of the claim. The language used by the applicant presents uncertainty with respect to the question of scope of the claim.

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

9. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by either Hart et al. (US 3,970,584) or Randen (US 4,816,256) or Knowles, Jr. et al. (US 5,575,988) or Thomas et al. (US 5,610,130).

Hart et al. teach oil-in-water emulsions containing insect repellents, such as N,N-diethyl-m-toluamide, and nonionic emulsifiers such as polyoxyethylene stearate and oleate, polyethoxylated cetyl alcohol, mono-, di- and tri- esters of various polyols, glycerol monostearate, sorbitan tristearate and sorbitan dioleate, in the claimed concentrations. See Abstract; col. 3, lines 4, 23-30; col. 10, Example VI.

Randen teaches mosquito repellent compositions which can be prepared as oil-in-water emulsions, comprising 1-10% of oil-in-water emulsifying agents such as cetareth-20, glyceryl monostearate, and 10-70% of DEET. See col. 6, line 63; col. 7, lines 30-40; col. 9, Examples.

Knowles, Jr. et al. teach sunscreen/insect repellent compositions which can be prepared as oil-in-water emulsions, comprising 0.01-10% of an emulsifying agent such as glyceryl hydroxystearate and 0.5-95% of DEET. See col. 2, lines 35-43; col. 3, lines 29, 54-55; col. 5, Example 2.

Thomas et al. teach oil-in-water microemulsions containing 0.1-20% of ethoxylated glycerol-based non-ionic surfactants and 0.5-20% of insect repellents such as DEET. See Abstract; col. 4, lines 1-7; col. 5, lines 33-34.

Applicant's functional language regarding the properties of the emulsifiers A would have been inherent to the emulsifiers disclosed in the references. A compound and all of its properties are inseparable. In re Papsech, 315 F2d. 381, 137 USPQ 43, (CCPA 1963).

Thus, Hart et al. or Randen or Knowles, Jr. et al. or Thomas et al. teach each and every limitation of Claims 1-4.

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10. Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by either Kaplan (US 5,989,529) or McShane et al. (US 6,099,825).

Kaplan teaches oil-in-water sunscreen compositions containing 0.05-20% of emulsifiers such as PEG-45/ dodecyl glycol copolymer, polyglyceryl-3-diisostearate, sorbitan trioleate, etc., and up to 15% of insect repellents such as DEET. See col. 1, line 50; col. 4, lines 36-65; col. 5, lines 25-29; col. 6, lines 42-62.

McShane et al. teach sunscreen oil-in-water emulsions containing 0.05-20% of at least one emulsifier (e.g. PEG-45/ dodecyl glycol copolymer, polyglyceryl-3-diisostearate, sorbitan trioleate, cetareth-15) and up to 15% of an insect repellent such as DEET. See Abstract; col. 5, lines 2-4, 29-60; col. 6, lines 4-8; col. 7, lines 31-53.

Applicant's functional language regarding the properties of the emulsifiers A would have been inherent to the emulsifiers disclosed in the references. A compound and all of its properties are inseparable. In re Papsech, 315 F2d. 381, 137 USPQ 43, (CCPA 1963).

Thus, Kaplan or McShane et al. teach each and every limitation of Claims 1-4.

### ***Conclusion***

11. No claim is allowed at this time.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 4,756,905 discloses insect repellent compositions containing DEET and glyceryl stearate; US 5,518,712 and US 6,159,452 disclose sunscreen emulsions containing DEET and PEG-40 stearate; US 5,989,527 discloses topical compositions containing insect repellents.

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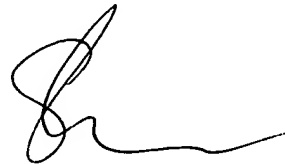
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (703) 306-4541.

The examiner can normally be reached on Monday to Friday from 9 to 5.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

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3/13/01



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Shelley A. Dodson  
Primary Examiner  
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